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EXAMINER

ZURITA, JAMES H

ART UNIT PAPER NUMBER

3625

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,526

Applicant(s)

CARROLL ET AL.

Examiner

James H. Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to..
- 8) ☒ Claim(s) 5-12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

CB

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Invention I, claims 1-4, in the reply filed on 2 August 2005 is acknowledged.

The traversal is on several grounds:

First, in the interests of equity and fairness, Applicants should be entitled to pursue different types of claims in the present application, particularly, apparatus claims and method claims, for the invention to fully protect the invention, because there is a different body of law pertaining to each of these different types of claims. The restriction requirement is therefore unfair to Applicants, because it will require Applicants to file and bear the additional cost and time delay associated with filing one or more divisional or continuing applications in order to cover each type of claim set.

These arguments are not found persuasive. The Examiner respectfully notes that should the method claims be found allowable, related apparatus that are withdrawn from consideration as a result of a restriction requirement may be rejoined.

Applicant also argues that there is no serious burden on the Examiner:

Second, as provided in 35 U.S.C. § 121, restriction to one of two or more claimed inventions is proper only if the inventions are "independent and distinct." In its discussion of the propriety of restrictions, MPEP § 803 further provides that if search and examination of two or more inventions can be made without "serious **burden**," the Examiner must examine them on the merits even if the claims are directed to distinct or independent inventions.

In the present case, Groups I and II, although not necessarily obvious in view of each other, are very similar in subject matter. More specifically, each pertains to operating a service over a computer network. For this reason, Applicants respectfully submit that the inventions described in these claims are not "independent" as defined in MPEP § 803 and that the restriction requirement therefore is improper as between Groups I and II. Indeed, it appears that a search for apparatus and situation, it clearly would not be overly **burdensome** on the Examiner to check for both of these "separate" inventions at the same time.

These arguments are not found persuasive. The Examiner respectfully disagrees and notes that applicant nowhere asserts that the various embodiments are

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obvious variations over another, although applicant appears to agree that the inventions are not patentably distinct.

The Examiner also respectfully disagrees with applicant's comments that such searches would not be overly burdensome. The Examiner respectfully notes that the Office requires that Examiners search claims without limiting searches to particular classes and subclasses. Thus, any search must include various types of searches, including textual searches and image searches of all classes and subclasses in each of multiple databases of US patents, PG-PUBS, foreign patents, non-patent literature, the Internet and Internet archives.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

In claims 1-4, contain the phrase "...to enable..." renders the claims indefinite, since mere use of the term does not define how an action is carried out.

Claims 2, 3 and 4 refer to "...an additional service provider..." There is no mention of a previous or first service provider.

Claim 2 refers to "...the contract negotiation phase..." but lacks antecedent basis, since parent claim 1 refers only to a "...contract formation phase..." and "...contract execution phase..."

Claims 2, 3, 4 each refer to "...additional service provider..." It is not clear how many service providers are claimed. Similarly, it is not clear how many different

interfaces between "...the additional service provider and the network..." are being claimed.

Claim 4 refers to contract formation and execution phases. The claim will be interpreted to read "...contract formation phase and contract execution phase..."

Claim 4 refers to "... wherein an additional service provider **which** is involved in the transaction..." It is not clear what is being addressed by the word **which**.

Drawings

The drawings are objected to because Figs. 1 and 2 contain a series of boxes and arrows without corresponding text.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character **30** refers to sub-contractor (paragraph 40) and to selected print provider (paragraph 43). In Fig. 1, Reference 16 is used to point to different items.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims contain the term **or**. The term renders the claims indefinite, since it is not possible to determine the scope of the claim as requiring both items or only one of the items separated by the or. For purposes of this examination, examiner will give the term its broadest reasonable interpretation and consider that the particular condition is satisfied if one of the limitations is met.

In claim 1, the term product or service will be interpreted to include either product or service. Similarly, "...customer or vendor interface..." will be interpreted to include either customer interface or vendor interface.

In claim 1, the limitation will be met where prior art discloses:

- [messages ...contract formation phase ... being enabled for transmission...] **OR** [for utilisation ...interface]
- [messages ... contract execution phase ... being enabled for transmission...] **OR** [for utilisation ...interface]

In claim 2, the limitation will be met where prior art discloses:

- [to enable ... contract formation phase ... the additional service provider] **OR** [where created by the additional service provider].

In claim 3, the limitation will be met where prior art discloses:

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- [to enable ...contract execution phase... the additional service provider] **OR** [where created by the additional service provider],

In claim 4, the limitation will be met where prior art discloses:

- to enable network messages relating to the contract formation phase and contract execution phase of the transaction to be utilised by the additional service provider[**OR** [where created by the additional service provider]

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by **Durante** et al., A Model for the E-Service Marketplace, copyright date 2000, retrieved from the Hewlett-Packard web site on 14 October, 2005.

At the onset, the Examiner notes the following:

- B2B (Business-to-Business) is the electronic exchange of products and services between businesses. Related businesses have collaborated on the creation of Internet-based supply-chain networks. Definition of B2B, MICROSOFT Computer Dictionary.
- A network is a group of computers and associated devices that are connected by communications facilities. Definition of network, MICROSOFT Computer Dictionary.
- An interface is a point at which a connection is made between two elements so that they can work with each other or exchange information. MICROSOFT Computer Dictionary.

In **Durante**,

- the nodes on the network include buyer computers, seller computers (E-service provider), negotiator computers, auditor computers that monitor messages between buyer and seller (E-service provider).
- Applicant's "...contract formation phase of a transaction..." corresponds to Fig. 4.1.3, Negotiation and Contract phase.
- Applicant's "...contract execution phase of the transaction..." corresponds to Fig. 4.1.5, Fulfillment and Settlement phase.
- Applicant's various "...interface..." correspond to lines that denote connection points among the various nodes, as in Fig. 4.1.3, 4.1.4, 4.1.5.

As per claim 1, Durante discloses method(s) of operating a service [E-service] over a computer network [peers, B2B connections, for example] comprising transactions in which customers [buyers, as in Introduction] purchase products and services from vendors [sellers, E-service Providers of Figs. 4.1.3, 4.1.4] in return for payment [see table 3.1, for example; see also Fig. 3.2.7 and references to payment],

(a) **wherein** a customer and a vendor negotiate during a contract formation phase of a transaction [see, for example, 4.1.3, Negotiation and Contract phase] and in which a product or service is supplied to the customer during a contract execution phase of the transaction see, for example, 4.1.5, Fulfillment and Settlement phase]

(b) there being an customer interface between the customer and the network [see interface between buyer and negotiator [see, for example, Fig. 4.1.3, which shows a connection between a buyer and a negotiator].

- **to enable** messages transmitted on the network according to a network protocol to be utilised by the customer [as in Fig. 4.1.4, which shows messages traveling from buyer to seller; the messages are utilized by the customer to communicate with a seller];
- **to enable** messages originating from the customer to be transmitted onto the network according to the network protocol [again, see transmission of messages, as in Fig. 4.1.4, and

an vendor interface between the vendor and the network

- **to enable** messages transmitted on the network according to a network protocol to be utilised by the vendor [as in Fig. 4.1.3, messages from an E-service

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provider and a negotiator, for example, and as in Fig. 4.1.4, to transmit messages to and from buyers] and

- **to enable** messages originating from the vendor to be transmitted onto the network according to the network protocol [again, see transmission of messages, as in Fig. 4.1.4, and

wherein the method includes differentiating

- messages relating to contract formation phase and contract execution phase of the transaction, see, for example, Fig. 4.1.4, *messages*, that travel between buyers and sellers (E-Service provider);
- messages relating to the contract formation phase of the transaction being enabled for transmission onto the network [...**or** for utilisation by the customer **or** vendor by a first **sub-interface** of the respective customer **or** vendor interface...] see, for example, references to contracts that may get registered with a registry; see also messages that are requests for offer and messages that are offers presented for negotiation; and
- messages relating to the contract execution phase of the transaction being enabled for transmission onto the network[...] **or** for utilisation by the customer **or** vendor by a second **sub-interface** of the respective customer **or** vendor interface....] see, for example, Fig. 4.1.4, concerning contract execution phase and messages between buyer and E-Service Provider.

As per claim 2, Durante discloses

- **wherein** an additional service provider is involved in the transaction during the contract negotiation phase of the transaction only (see, for example, references to service providers such as contract registry, notary, for example) and plays no part in the contract execution phase of the transaction (contract registry, notary play no part in the contract execution phase (Fig. 4.1.4).
- there being an interface between the additional service provider and the network (see, for example, lines that connect contract registry and notary to other nodes on the network shown in Fig. 4.1.3),

the method including implementing a [...] functionality only

- **to enable** network messages relating only to the contract formation phase of the transaction to be utilised by the additional service provider **or where** created by the additional service provider. In Fig. 4.1.3, see, for example, interface lines between negotiator and notary that permit contract signatures to be notarized;
- **to enable** these messages to be transmitted onto the network according to the network protocol. For protocols, see, for example, at least Fig. 3.1.3, which discloses interaction protocol specifications.

As to claim 2, the Examiner notes that while the functionality is referred to as a "...first sub-interface functionality..." the label "...first sub-interface..." is descriptive material plays no active role in the method step and does not distinguish the present invention in terms of patentability.

As per claim 3, Durante discloses

- **wherein** an additional service provider is involved in the transaction during the contract execution phase of the transaction only (see Fig. 4.1.5, for example, auditor, contract enforcer) and plays no part in the contract formation phase of the transaction (auditor and contract enforcer are absent from Fig. 4.1.3),
- there being an interface between the additional service provider and the network. See, for example, interfaces shown as lines between auditor and other nodes on the network, as in Fig. 4.1.5.

the method including implementing a [...] functionality only

- **to enable** network messages relating only to the contract execution phase of the transaction to be utilised by the additional service provider **or where** created by the additional service provider, See Fig. 4.1.5, for example; and
- **to enable** these messages to be transmitted onto the network according to the network protocol. See Fig. 4.1.5.

As to claim 3, the Examiner notes that while the functionality is referred to as a "...second sub-interface functionality..." the label "...second sub-interface..." is descriptive material plays no active role in the method step and does not distinguish the present invention in terms of patentability.

As per claim 4, Durante discloses

- **wherein** an additional service provider [...] is involved in the transaction during the contract negotiation phase of the transaction and the contract execution

phase of the transaction, see, for example, references to **negotiator** in both Fig.s 4.1.3 and 4.1.5.

- there being an interface between the additional service provider and the network, see, for example, lines that denote interfaces between the **negotiator** and other nodes on the network.

the method including implementing [...] multiple, including first and second functionalities:

- **to enable** network messages relating to the contract formation phase and contract execution phase of the transaction to be utilised by the additional service provider [...**or where** created by the additional service provider...]
- **to enable** these messages to be transmitted onto the network according to the network protocol. See Fig. 4.1.5. For protocols, see, for example, at least Fig. 3.1.3, which discloses interaction protocol specifications.

As to claim 4, the Examiner notes that while the functionality is referred to as a "...first and second sub-interface functionality..." the label "...second sub-interface..." is descriptive material plays no active role in the method step and does not distinguish the present invention in terms of patentability.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Zurita
Patent Examiner
Art Unit 3625
14 October 2005

James Zurita
Patent Examiner
Art 3625